



JAN 18 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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Supervisor, Patent Prosecution Services  
Piper, Marbury, Rudnick & Wolfe, LLP  
1200 Nineteenth Street, N.W.  
Washington, D.C. 20036-2412

In re Application of	:	
MOINEAU, et al.	:	
U.S. Application No.: 09/830,477	:	
PCT No.: PCT/CA99/01012	:	DECISION ON PETITION
Int. Filing Date: 29 October 1999	:	
Priority Date: 30 October 1998	:	UNDER 37 CFR 1.47(a)
Attorney Docket No.: SWA-003-US	:	
For: DNS RELAY MODULE IN A DIGITAL	:	
NETWORK MODEM	:	

This decision is in response to applicant's "Petition Under 37 C.F.R. 1.47(a)" filed 23 October 2001 in the United States Patent and Trademark Office (USPTO).

### **BACKGROUND**

On 29 October 1999, applicant filed international application PCT/CA99/01012, which claimed priority of an earlier application filed 30 October 1998. A copy of the International Application was forwarded to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 11 May 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 29 May 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 April 2001.

On 27 April 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the International Search Report and a copy of the International Preliminary Examination Report. An executed oath or declaration was not included.

On 23 May 2001, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International Application number and international filing date. Applicant prepaid the \$130.00 surcharge for providing an oath or declaration later than thirty months from the priority date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 23 October 2001, applicant responded with the present petition to accept the present oath or declaration without the signature of joint inventor Jerome DUPLAIX accompanied by a check in the amount of \$590.00 (\$130.00 for the petition fee for a petition under 37 CFR 1.47(a) and \$460.00 as payment for a three-month extension of time); a petition for a three-month extension of time, and a declaration executed by joint inventor Gilbert MOINEAU. With the filing of the petition for a three-month extension of time and payment of fee, applicant's petition is considered to be timely filed.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(i), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. With the filing of the present petition and accompanying papers, applicant has satisfied all four items and it is appropriate to grant the petition under 37 CFR 1.47(a).

Regarding item (1), applicant has provided payment of the appropriate petition fee.

As to item (2), applicant has provided first-hand accounts of the attempts to provide Mr. DUPLAIX a complete set of application papers and a declaration for execution, as well as, attempts to locate Mr. DUPLAIX through his last known address and the use of various telephone and on-line directories.

Regarding item (3), applicant has supplied a statement of the last known address of Mr. DUPLAIX.

As to item (4), applicant has a combined declaration and power of attorney executed by joint inventor Gilbert MOINEAU on his own behalf and on behalf of Mr. DUPLAIX.

### CONCLUSION

For the reasons above, the petition is GRANTED.

The application has an international filing date of 29 October 1999 under 35 U.S.C. 363, and will be given a date of **23 October 2001** under 35 U.S.C. 371 (c).

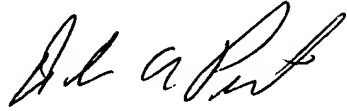
As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at her last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the DO/EO/US for processing in accordance with this decision.

A handwritten signature in black ink, appearing to read 'Richard Cole', written in a cursive style.

Richard Cole  
Legal Examiner  
PCT Legal Office

A handwritten signature in black ink, appearing to read 'Derek A. Putonen', written in a cursive style.

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Mr. Jerome Duplaix  
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In re Application of  
MOINEAU, et al.  
U.S. Application No.: 09/830,477  
PCT No.: PCT/CA99/01012  
Int. Filing Date: 29 October 1999  
Priority Date: 30 October 1998  
Attorney Docket No.: SWA-003-US  
For: DNS RELAY MODULE IN A DIGITAL  
NETWORK MODEM

Dear Mr. Duplaix:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternately, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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Legal Examiner  
PCT Legal Office

Derek A. Putonen  
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